

DOCKET NO: 242401US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
KOJI OKA, ET AL. : EXAMINER: LAM, H.
SERIAL NO: 10/658,549 :
FILED: SEPTEMBER 10, 2003 : GROUP ART UNIT: 2622
FOR: DIGITAL CAMERA, METHOD FOR :
SENDING IMAGE DATA AND SYSTEM
FOR TRANSMITTING AND RECEIVING
IMAGE DATA

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This Reply Brief is responsive Examiner's Answer of May 28, 2009.

The Examiner's Answer does not raise any new ground of rejection although there are new explanations made by the Examiner with respect to claim interpretation and the prior art which was used to reject the claims.

I. Interpretation of "Broadcast Request Data Over Said Local Area Network"

In the Appeal Brief, clear arguments were presented relating to the interpretation broadcasting over a local area network. See pp. 4-5 of the Appeal Brief.

Instead of addressing the complete phrase recited in the claims which pertains to broadcasting over a local area network, the Examiner's Answer relies on a non-technical dictionary definition which is outside of the field of computing or computer networks for just one of the words at issue, "broadcast". At the top of p. 6 of the outstanding Office Action, the Examiner is relying simply on the definition of "broadcast" from Merriam-Webster's

College Dictionary. However, this is the wrong dictionary for the wrong term. Looking at the specific claim language, the following terms are in dispute:

Claim 1 – “broadcast request data over said local area network,”

Claim 6 – “broadcasting request data to said local area network,” and

Claim 7 – “broadcast request data to said local area network.”

The first error made by the outstanding Office Action is to rely on a non-technical dictionary. The Federal Circuit “has repeatedly cautioned against using non-scientific dictionaries for defining technical words.” *AFG Industries, Inc. v. Cardinal IG Co., Inc.*, 239 F.3d 1239, 1247-8 (Fed. Cir. 2001). The second error made is to not interpret the phrase “broadcast request data over said local area network” but to look at the word “broadcast” in isolation. Broadcasting over a computer network has a specific meaning to one of ordinary skill in the art, and the Appeal Brief was filed with an exemplary reference to RFC 919 related to broadcasting over computer networks. If the Examiner was relying on a dictionary which explains what it means to broadcast over a computer network, that would be acceptable. However, the Examiner’s reference is just to “broadcasting” in the context of “radio or television” which is improper. Examiner’s Answer at the top of p. 6.

It is fully acknowledged that the Examiner is entitled and required to provide the claims with their broadest reasonable interpretation. However, the interpretation must be of the proper term in the proper context, and no attempt has been made by the Examiner’s Answer to address the term “broadcasting” in the context of a computer network, as recited in the claims, using an appropriate dictionary or source.

For at least this first reason, the rejection of the examiner of each of the claims should be REVERSED.

II. The Prior Art Does Not Teach “From Which Said Response is Sent”

As explained in the Appeal Brief, during the prosecution of this application, the Examiner overlooked or ignored the term "from which said response is sent." The Examiner's Answer contains a new and creative argument which attempts to address this issue. However, the explanation and assertion made on this issue in the Examiner's Answer is meritless.

A deficiency of Werner (U.S. 2003/0202104) is that it is missing the feature of "said control device detects an IP address of the piece of equipment from which said response is sent." Werner is simply missing the feature of "from which said response data is sent." For the first time during the course of the extensive prosecution of this application has the Examiner attempted to explain in the Examiner's Answer how this feature is disclosed in Werner. Werner discloses the use of a service provider and one or more separate photo processing establishments. In order to address the deficiency of Werner, the Examiner's Answer asserts that the separate location based service provider and the photo processing establishments are the same piece of equipment, something which is clearly erroneous. Specifically, the Examiner's Answer states:

Therefore, it is reasonable to interpret the combination of the location-based service provider and one of the photo processing establishment as a set of one of physical resources, system or "a piece of equipment" of the claim invention.

Throughout Werner, the service center and the photo processing establishments are geographically diverse and separate. Each photo processing establishment has a different physical address and different network address, and nothing equates the physical address of the photo processing establishment with the address of the service provider.

As Werner does not disclose, suggest, or permit the service provider to be the same piece of equipment as the photo processing establishments, each of the independent claims are clearly patentable for this second reason.

III. The Prior Art Does Not Teach "Sending of Image Data to The Piece of Equipment"

Issue 3 is similar to the second issue addressed above. What is required in Claim 1, for example, is sending "the image data which is stored in said storing device to the piece of equipment which includes the detected IP address."

This feature of Claim 1 requires the image data to be sent to the equipment at the IP address which has been detected. The claim requires that the IP address correspond to the piece of equipment which has responded to said request data. As seen in step 1214 of Figure 12 of Werner, it is the service provider that sends the physical address and the image data must be sent to that piece of equipment. In Werner, the images are not sent to the service provider which is at the detected IP address, but are sent to a photo processing establishment at a different address. Similar to the second issue explained above, the service provider and the photo processing establishments are not the same piece of equipment and do not have the same IP address.

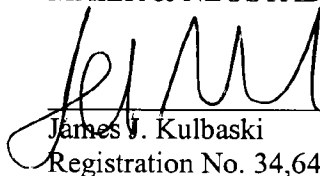
However, the Examiner's Answer interprets the claimed IP address as "one or more IP addresses." See the top of p. 4 of the Examiner's Answer. Again, the outstanding Office Action is ignoring the requirement of the claim and attempting to twist Werner to show something which it clearly doesn't show.

For at least this third reason, the claims are not anticipated by Werner.

Accordingly, the rejection under 35 U.S.C. §102 is respectfully requested to be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


James V. Kulbaski
Registration No. 34,648

Customer Number
22850
Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)